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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,640	02/20/2004	Timo Saari	0837-0164P	3444
2292	7590	06/26/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/781,640

Applicant(s)

SAARI ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/22/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Remarks**

1. Preliminary amendment filed on 2/22/2004 has been received and entered. Claims 1-20 are pending.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. Acknowledgment is made of Con. Of PCT/FI02/00678 8/19/2002.

### ***Claim Objections***

4. Claims 8, and 18 are objected to because of the following informalities:

Claims 8, and 18, both recite the single mean recitation (only one instance) which is improper according to *MPEP* 2164.08(a) Single Means Claim:

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for

achieving the stated property (result) while the specification discloses at most only those known to the inventor. Correction is required.

5. Independent claim 1 is directed to "A method" as recited in the preamble, later on, dependent claims 2-10, are introduced with the statement of "A method as claimed in claim 1" making it vague and unclear to the Examiner if these are new methods separate from the proceeding ones taking place after the initial process? Or if the claims are meant to be independent claims? And therefore should be written as such. Claims 2-10 lack sufficient antecedent basis. Similarly, dependent claims 12-20 have similar deficiency.

All dependent claims should be amended to start with the recitation "The method of claim 1, etc."

6. Claims 10, and 20, both, recite "**for** converting", respectively, is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase "**for**" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "**for**" do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

More direct, firm language such as "to convert", or "converting" is suggested.

#### ***Double Patenting***

Art Unit: 2165

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, and 13 of copending Application No. 10/781,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application is directed to creating a rules database...creating a database descriptive of content...creating a database descriptive of reaction...comparing parameters...and creating metadata file, similarly, claim 1 of copending application '673 is directed to creating a rules database...creating a database descriptive of content...creating a database descriptive of reaction...creating metadata file...and using the metafile for comparison. Thus claim 1 of the instant application is arguably broader than claim 1 of application '673.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1, and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce reproducible results. To be tangible the claimed invention must produce a practical application or real world result. In this case the claims fail to produce tangible output or real world result to the final “creating” in the claims since no storage or presentation takes place in order to realize the “creating”. Claims should be amended to recite an output such as storing the created metadata files or presenting them for output.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-3, 6-8, 11-13, 15-18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Regarding claims 10, and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

14. Claim 1 recites the limitation "the personalization" in the preamble. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the users" in the preamble. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the reaction" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the reactions" plural in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the actual" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the essential" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said measurement" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the use" in line 2. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what/ when "the use" is taking place? And what is being used? Is it meant to be a functionality of the system or the user? Clarification if required.

Claim 6 recites the limitation "the linking relations" in line 6. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what/ who is meant by "the relations of the user"? Is it relations between users? Or the relations between the user and the system? Clarification is required.

Claim 7 recites the limitation "the user's generic user category" in line 8. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what is a generic category? Where did it come from since there



was no prior mention of any categories? What meant by the distinction of “generic”? How is it related to “the user”? Clarification is required.

Claim 8 recites the limitation "the linking" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claims 8, and 18, both recite “their” which is indefinite language for failing to particularly point out and distinctly claim the subject matter which is being referenced.

Claim 10 recites the limitation "the appearance" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the content of information services" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the users" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the actual" in line 20. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the essential" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "said measurement" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the reactions" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the use" in line 2. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what/ when "the use" is taking place? And what is being used? Is it meant to be a functionality of the system or the user? Clarification is required.

Claim 16 recites the limitation "the linking relations" in line 6. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what/ who is meant by "the relations of the user"? is it relations between users? Or the relations between the user and the system? Clarification if required.

Claim 17 recites the limitation "the user's generic user category" in line 6. There is insufficient antecedent basis for this limitation in the claim. Also, the recitation appears to be indefinite for failing to point out what is a generic category? Where did it come from since there

was no prior mention of any categories? What meant by the distinction of “generic”? How is it related to “the user”? Clarification is required.

Claim 18 recites the limitation "the linking addresses" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the appearance" in line 3. There is insufficient antecedent basis for this limitation in the claim.

15. Claims 1, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps with respect to applicant's specification paragraph 22 are: pertaining to recitation of “stimuli presented” in claim 1, line 8, without any prior mention of when or how was this stimuli first introduced for presentation and what is considered a stimuli in order to produce a reaction in the users? There is no definition as to what constitute this stimuli and to what extent it impacts?

16. Claim 1, preamble recite “**for use**” is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase “**for**” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “**for**” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data

without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

There appears to be no nexus between the intended use of the preamble and the body of the claim in order to realize the functionality intended. The "the personalization of media services...and arrangement to be stored" appear to be missing of the body of the claim.

Similarly, claim 11, recite "media service information" without any further mention of the "media service" in the body of the claim. Thus lacking any nexus between the preamble and the body of the claim since there's no indication what-so-ever to having a service at the first place and it, being a media related service.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Carey et al. (U.S. Pub. No. 2002/0112035 A1).

As to claims 1, and 11, Carey et al. teaches a method of creating metadata files for use in the personalization of media services in an information system including an information content database, in which parameters descriptive of the content of information services are arranged to be stored, and a user profile database, in which parameters descriptive of the users of information services are arranged to be stored, the method comprising:

creating a rulebase including the reaction impulses of a test user group to information stimuli presented (See page 4, paragraph 0055, also see page 5, paragraph 0075);

creating a database descriptive of an information content space and including theoretical alternatives for the parameters descriptive of the content of the information services (See page 4, paragraph 0055, also see page 7, paragraph 0096, and page 7, Table 3.1, shows different parameters);

creating a database descriptive of a user profile space and including theoretical alternatives for the parameters descriptive of the users of the information services (See page 4, paragraph 0055, also see page 5, paragraph 0070);

creating a database descriptive of a reaction space and including theoretical alternatives for parameters descriptive of the reactions of the users of the information services, the database

being created as an interaction of the database descriptive of the information content space and the database descriptive of the user profile space, the interaction being specified based on the reaction impulses defined in the rulebase (See page 4, paragraph 0055, also see page 6, paragraphs 0078-0087);

comparing the actual parameters descriptive of the content and the users of the information services with the theoretical parameters (See page 7, paragraphs 0103-0106); and creating metadata files as a result of said comparison for at least one user of an information service and for at least one content of an information service based on the reaction impulses defined in the rulebase (See page 6, paragraph 0088, also see page 9, paragraph 0130, and see page 11, paragraph 0140).

#### ***Allowable Subject Matter***

19. Although no rejections in view of prior art are made with regards to dependent claims, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

#### ***Closest prior art of Record***

20. Wilkinson et al. (U.S. Pub. No. 2002/0174182 A1) teaches real time reaction to simulation in electronic service management system.

Yuen (U.S. Patent No. 7,003,792 B1) teaches smart agent collection in a local client based on psycho-demographic profile of the user.

J.M. Serrano, M.A. Vila, V. Aranda, & G. Delgado. *Using Fuzzy Relational Databases to Represent Agricultural and Environmental Information.* Dept. of Computer Science & AI. University of Granada. Research Paper Mathware & Software Computing 8 (2001).

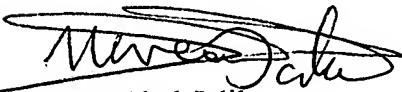
***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil  
June 23, 2006